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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/586,152  | 07/14/2006  | Naoto Kuroda         | Q95967              | 5614             |
| 72875 7590 05/14/2009<br>SUGHRUE MION, PLLC<br>2100 Pennsylvania Avenue, N.W.<br>Washington, DC 20037 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| WONG, JOSEPH D  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2166  |             |                      |                     |                  |
| NOTIFICATION DATE   |             | DELIVERY MODE        |                     |                  |
| 05/14/2009  |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@sughrue.com  
kglyndman@sughrue.com  
USPatDocketing@sughrue.com

### Office Action Summary

**Application No.**

10/586,152

**Applicant(s)**

KURODA, NAOTO

**Examiner**

JOSEPH D. WONG

**Art Unit**

2166

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- Paper No(s)/Mail Date 20080717, 20080714

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's foreign priority claim to Japanese Patent Application No. 2004-008964 is acknowledged in view of English translation provided on 12 March 2009.

### ***Response to Arguments***

#### **Information Disclosure Statement**

IDS filed 17 July 2008 has been considered.

IDS filed 14 Jan 2006 has been considered and lined through for reasons discussed below. Applicant is requested to inspect the records in PAIR to specifically point out page counts or when submissions mentioned on page 9, paragraph 1 of the instant remarks were received. The Examiner has carefully reviewed the image file wrapper and did not immediately see the submission cited by Applicant in the instant remarks. Foreign references on IDS dated 14 July 2006 cited by Applicant cannot be considered unless COPIES conforming with 37 CFR 1.97-198 are provided. Consequently, Applicant's assistance in pinpointing the location of said submission within the file wrapper or correcting this submission question would be greatly appreciated.

#### **Rejection under 35 U.S.C. §101**

A “judgment screen” positively recited in claim is interpreted under present evaluation to necessarily imply the presence of a physical article for purposes of evaluating statutory compliance. Nonstatutory subject matter rejections of claim 1 is withdrawn.

Nonstatutory subject matter rejections of claims 2-3 are maintained. Also see Office Action below. A “display unit” or “column” is interpreted under present evaluation to be either software instructions or an abstract descriptive matter thus not necessarily meeting the threshold of a physical article in claim 2. A computer program that is not necessarily executed on a functional element of a computer or physical article in claim 3 appears to raise statutory subject matter concerns. Therefore rejections of claims 2-3 are maintained.

#### Rejection under 35 U.S.C. §102

Arguments are fully considered but are moot in view of new grounds of rejection necessitated by the instant claim amendment.

For at least the reasons above, all pending claims stand rejected.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 2 is rejected for being directed towards nonstatutory subject matter.**

Claim 2 is directed toward a data structure for judging whether a computer apparatus is connected to a network. This apparatus claim does not necessarily recite a physical article within

the body of the claim. Consequently it appears directed towards software per se. Therefore claim 2 is rejected.

Claim 3 is directed towards a computer readable recording device storing a computer program for executing a method on a computer apparatus. However, the "for" clause is an intended use clause and does not necessarily require the program to execute upon a computer apparatus. Furthermore, since no physical article necessarily recited within the claim, it is unclear whether the computer or CPU or processor is necessarily present since the purported "computer apparatus" is recited in the preamble only. Therefore claim 3 is rejected.

Applicants can look to MPEP 2106.01-2106.02 (July 2008), Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Instant Specification, and contemporary case law with a matching fact pattern for further suggestions that may be helpful in overcoming these rejections.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hough, (US 2003/0079024 A1), hereinafter Hough.**

**As to claim 1**, Hough teaches a network connection presence or absence judging method of judging whether a computer apparatus is connected to a network (Figs. 2, 4), wherein: the computer apparatus performs the operations comprising: reading hypertext data (see “URL”, ¶[6]), stored in a storage medium not connected to the network (Fig. 1, items 29, 31, interpreted to include removable media as shown), that includes data for displaying a network connection presence or absence judgment screen including a network connection presence or absence judgment column indicating whether the computer is connected to a network and a document indicating a meaning of the network connection presence or absence judgment column (Figs. 2, 4; “Online” and “Not Online”), and includes positional information indicating a position of external image data displayed in the network connection presence or absence judgment column acquired via the network other than positional information data indicating a position of a link destination to be displayed corresponding to a user request (see Fig. 2, item 116; Fig. 4, item 116, also see ¶ [33], “user is either not using or away from his/her computer...user may have signed out or not have signed into the messaging service” ); displaying a network connection presence or absence judgment screen including the network connection presence or absence judgment column and the document indicating a meaning of the network connection presence or absence judgment column on the basis of the read hypertext data (Figs. 2, 4, see “Online” and “Not Online”), and detecting (¶ [31-33]), a positional data indicating a position of external image data acquired via the network (¶ [31-33]); and displaying an external image on the basis of the external image data in the network connection presence or absence judgment column (Figs. 2, 4), if the external image data can be acquired via the network (Figs. 2, 4; ¶ [31-33]), and displaying (Figs. 2, 4), an alternative image preliminarily set in the network connection presence or absence

judgment column (Figs. 2, 4), (optional alternative) if the external image data can not be acquired via the network (§[31-33]).

**As to claim 2**, Hough teaches a computer apparatus configured to determine whether the computer apparatus is connected to a network (Figs. 2, 4), comprising: a data reading unit configured to read hypertext data (see “URL”, §[6] ), stored in a storage medium not connected to the network (Fig. 1, items 29, 31, interpreted to include removable media as shown), that includes data displaying a network connection presence or absence judgment screen including a network connection presence or absence judgment column indicating whether the computer is connected to a network and a document indicating a meaning of the network connection presence or absence judgment column (Figs. 2, 4; “Online” and “Not Online”), and includes positional information indicating a position of external image data to be displayed in the network connection presence or absence judgment column acquired via the network other than positional information data indicating (Figs. 2, 4 see position of icons or avatars under subheadings); a positions of a link destination to be displayed corresponding to a user request (see Fig. 2, item 116; Fig. 4, item 116, also see § [33], “user is either not using or away from his/her computer...user may have signed out or not have signed into the messaging service” ); a display unit configured to display a network connection presence or absence judgment screen including the network connection presence or absence judgment column and the document indicating a meaning of the network connection presence or absence judgment column on the basis of the read hypertext data (see “URL”, §[6] ), and configured to detect a positional data indicating a position of external image data acquired via the network (§ [31-33]); wherein the display unit is configured to display an external image on the basis of the external image data on the network

connection presence or absence judgment column. if the external image data can be acquired via the network (Figs. 2, 4; ¶ [31-33]), and is configured to display an alternative image preliminarily set in the network connection presence or absence judgment column, (optional alternative) if the external image data can not be acquired via the network (Figs. 2, 4; ¶ [31-33]).

**As to claim 3**, Hough teaches a computer readable recording device storing a computer program for executing a method on a computer apparatus (Figs. 2, 4),, comprising: reading hypertext data (see “URL”, ¶[6] ), stored in a storage medium not connected to the network (Fig. 1, items 29, 31, interpreted to include removable media as shown), that includes data for display in a network connection presence or absence judgment screen including a network connection presence or absence judgment column indicating whether the computer is connected to a network and a document indicating a meaning of the network connection presence or absence judgment column (Figs. 2, 4; “Online” and “Not Online”), and includes positional information indicating a position of external image data displayed in the network connection presence or absence-judgment column acquired via the network other than positional information data indicating a position of a link destination to be displayed corresponding to a user request (see Fig. 2, item 116; Fig. 4, item 116, also see ¶ [33], “user is either not using or away from his/her computer...user may have signed out or not have signed into the messaging service”); displaying a network connection presence or absence judgment screen including the network connection presence or absence judgment column and the document indicating a meaning of the network connection presence or absence judgment column on the basis of the read hypertext data (see “URL”, ¶[6] ), and detecting a positional data indicating a position of external image data acquired via the network (Figs. 2, 4; ¶ [31-33]); and displaying an external image on the basis of



the external image data on the network connection presence or absence judgment column (Figs. 2, 4), (optional alternative) if the external image data can be acquired via the network ( ), and displaying an alternative image preliminarily set in the network connection presence or absence judgment column (Figs. 2, 4), (optional alternative) if the external image data can not be acquired via the network (Figs. 2, 4; ¶ [31-33]).

### *Conclusion*

Applicant's amendment necessitated the amended citations (or new ground(s)) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If applicant still believes there is patentable subject matter within the disclosure and has reasons why those differences define over the prior art, then applicant can look to MPEP § 324 IV (September 2007) and 37 CFR 1.114 for additional suggestions that may be helpful for overcoming the finality of this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is (571) 270-1015. The examiner can normally be reached on Monday through Friday, 10 AM – 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JDW/

Asst. Examiner, Art Unit 2166

12 May 2009

/S. L./, May 8, 2009

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/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166